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and can be used to provide smooth surfaces for painting or as the finished surface after the melt-flowable sheet has been bonded to a surface.

### **REMARKS**

The remarks below respond to the Office Action mailed August 1, 2001.

Claims 6-32 are pending in the application. With this response, no claims have been amended or added. Claims 6-32 remain in the application for consideration.

No new fee is believed to be due at this time.

Reconsideration and allowance of the claims in view of the following remarks are respectfully requested.

### **The Objection to the Specification**

The specification was objected to as failing to provide proper antecedent basis for the claimed subject matter. According to the Office Action, "there is no apparent explicit support in the specification for the limitation in claims 28-29 that the dimensionally stable films have a smooth surface."

The Examiner requests amendment to the specification at page 27, line 17. Applicants have made the suggested amendment to the specification and it is respectfully requested that the objection to the specification be withdrawn.

The Office Action further suggests amendment of the word "comprising" in claim 29 at line (a)8 and (b)9. Applicants believe that claim 29, as drafted and amended, is not subject to objection and is supported by the specification as amended. The term "comprising" is a term in the patent art that should not be objectionable, particularly here, where the specification is being amended to adapt the specification to the claims.

It is respectfully requested that the objection to the specification be withdrawn.

### **Rejections Under 35 U.S.C. 112**

#### **"Topography"**

Claims 6-28 and 32 stand rejected under 35 U.S.C. section 112, first paragraph, based on the presence of the word "topography."

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**According to the Office Action:**

[T]he word 'topography' (which is nowhere employed in the specification in this regard) should be/have been deleted from line 7 of claims 6 (preferably along with the remainder of this line), and also from line 3 of claims 16 and line 10 of claim 28, the COMPLETE limitations found and held to be objectionable. (Citing page 4, lines 12-16 of the Board decision of January 30, 2001.)

**Applicants' Response**

Applicants respectfully disagree with the Examiner's interpretation of the Board decision.

Page 4, lines 12-16, of the Board decision, cited by the Examiner, states literally that the disclosure does not reasonably convey possession of "said [dimensionally stable] film having a pre-selected surface topography." Elsewhere, the Board decision also speaks in specific terms of a "pre-selected topography" and not generally of "topography": see, e.g., the Board opinion at page 3, lines 15-17 "the dimensionally stable film to have a preselected surface topography, i.e. 'said film having a pre-selected surface topography'"; page 4, last line, through page 5, line 2, "the disclosure . . . sets forth the definition and properties of dimensionally stable films but does not disclose anything about the pre-selected topography"; and, at the middle of page 5, "fail to find any basis for the pre-selected surface topography." (Emphasis added.)

Applicants read the Board opinion not as finding a lack of support for the general term "topography," but instead, as deciding on the specific feature "pre-selected" topography.

There is no lack of support for the more general term "topography" of a film, because all films have some topography. The American Heritage College Dictionary (1993) at page 1427 defines "topography" as: "4.b. The surface features of an object: *The topography of a crystal.*" (A copy of this page is included for the Examiner's convenience.) Films, being objects, have a topography. Therefore, by disclosing films generally, Applicants' disclosure implicitly or inherently discloses a film having a topography, meaning that the term "topography" in Applicants' claims is supported by the specification. It is therefore requested that the rejection under 35 U.S.C. section 112, first paragraph, of claims 6-28 and

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32, which have been amended to conform to the Board decision, to eliminate the phrase "pre-selected," be withdrawn.

"Dimensionally stable film"

The Office Action rejects claims 6-32 under 35 U.S.C. section 112, first paragraph, as not reasonably providing enablement for "just any (a) dimensionally stable film (claims 6-32); and (c) [sic, (b)] degree of cross-linking for this aforementioned film (claims 14-15 and 30, as noted by the BPAI in Footnote 2 on page 7 of their aforementioned decision)." The Office Action concludes: "The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims."

**Applicants' Response**

The rejection is traversed.

As an initial point, the Examiner's attention is respectfully directed to the Board decision, starting at the last paragraph of page 5 and continuing through the top of page 8, which describes the non-enablement rejection of record of claims 14, 15, and 29-31. In particular, on pages 6 and 7, the Board states that, with respect to this rejection, "the examiner has not met the initial burden of establishing why one of ordinary skill in the art could not practice the subject matter as claimed without undue experimentation. The examiner has not made the necessary factual findings to support a legal conclusion of lack of enablement. Appellants' specification, at page 27, ll. 10-22, does not disclose that it is critical that the epoxy-polyesters be cross-linked when used as dimensionally stable films but only teaches cross-linking epoxy-polyesters as examples of thermoset films." (emphasis added) In conclusion, the Board stated: "we determine that the Examiner has not presented the underlying factual inquiries to support his legal conclusion. Accordingly the Examiner's rejection of claims 14, 15 and 29-31 under 35 U.S.C. section 112, first paragraph, is reversed." (emphasis added)

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It is respectfully submitted that, as with this previous §112 rejection, the Office Action fails to provide any underlying factual findings to support the legal conclusion that claims 6-32 are not fully enabled by the present specification.

It is submitted that claims 6-32 are fully enabled by the specification as originally filed. Looking to Applicants' specification, for example from page 27, line 11 to page 30, line 12, there is clearly sufficient disclosure to enable one skilled in the art to practice the recited "dimensionally stable film," without undue experimentation. The Examiner is respectfully invited to re-read this cited passage of Applicants' original disclosure and reconsider the non-enablement rejection. There are over three pages of disclosure that teach the function, properties and chemical identities of a broad range of useful and preferred dimensionally stable films. Therefore, a broad range of dimensionally stable films are enabled.

The cited passage discloses and teaches dimensionally stable thermoset films, giving examples such as epoxy-polyester materials. Other disclosures include teachings on films made of polyester, polyethylene terephthalate, polyethylene, polypropylene, polyolefins, specific ultrahigh molecular weight materials in this group, and many others. The present application describes ultrahigh molecular weight polyethylene films having useful ranges of intrinsic viscosity. What is meant by a film that is "dimensionally stable" is also disclosed and taught. This passage describes preferred down web and cross web shrinkage values. Additives are described. Exemplary fillers and porosity are described. Useful commercially available films are identified. Patent references relating to suitable microporous films are identified. Combinations of useful dimensionally stable films are discussed and identified. Methods of improving thermostability of the films are discussed. Improving adhesion of the films is discussed. Etc.

Considering the substantial volume and specific content of the description in the cited passages supporting the claimed dimensionally stable film, the entire scope of the term "dimensionally stable film," as recited in claims 6-32, is enabled. Therefore, Applicants request that the rejection of claims 6-32 under 35 USC § 112, first paragraph, be withdrawn.

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**The Double Patenting Rejection**

The Office Action rejects claims 6-32 under the judicially created doctrine of obviousness-type double patenting, as being unpatentable over claims 1, 8, 12-13, and 20-32 of U.S. Patent No. 5, 964,979 (George et al.). The Office Action states that the conflicting claims are not identical but are not patently distinct from each other "because the same inventive concept is held to be involved in both instances, the (broader) instant claims being held/seen to encompass the (narrower) patented claims within their scope and definition."

**Applicants' Response**

The rejection is traversed.

Obviousness-type double patenting is a judge-made doctrine that prevents an extension of the patent right beyond the statutory time limit. It requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent. See In re Braat, 937 F.2d 589, 592, 19 USPQ2d 1289, 1291-92 (Fed. Cir. 1991). Its purpose is to prevent an unjustified extension of the term of the right to exclude granted by a patent by allowing a second patent claiming an obvious variant of the same invention to issue to the same owner later. See In re Goodman, 11 F.3d 1046, 1052, 29 USPQ2d 2010, 2015 (Fed. Cir. 1993). Generally, a "one-way" test has been applied to determine obviousness-type double patenting. Under that test, the examiner asks whether the application claims are obvious over the patent claims.

There are situations, however, when an extension of patent right is justified. See In re Borah, 345 F.2d 1009, 1009, 148 USPQ 213, 214 (CCPA 1966). In Braat, for example, the Federal Circuit applied a "two-way" test in such a situation. See Braat, 937 F.2d at 592. Under the "two-way" test, the examiner must also ask whether the patent claims are obvious over the pending application claims. See In re Berg, 46 USPQ2d 1226, 1229. It is submitted that the current situation justifies the application of the "two-way" test. The current application was filed years before U.S. Patent No. 5, 964,979 (George et al.). In addition, both the current application and the George et al patent are owned by the present assignee. Furthermore, the latter filed George et al patent issued first because the current application had been appealed to the Board. Applicants won on appeal on all of the substantive prior art

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issues. Therefore, it was the PTO that controlled the rates of prosecution of the two cases to cause the later-filed species claims to issue in the George et al patent before claims for the genus in the earlier filed current application. Accordingly, the "two-way" test applies to the current situation and the obviousness issue turns on the additional structure claimed in the George et al patent not the obviousness of the basic structure claimed in the current application.

With regard to one recited feature, the instant claims recite a "dimensionally stable film for controlling the melt-flow behavior of said melt-flowable composition." The claims in George et al. recite, in part, a "shaped, polymeric cap having a pre-selected, cross-sectional profile characterized by a second width and a shape in which the thickness of the cap across its width, the width of the cap, or both the width and the thickness of the cap vary." The shaped polymeric cap recited in the George et al. patent claims is an unobvious species of the genus film recited in the claims of the current application.

The claim to a dimensionally stable film, while overlapping the material formed into a shaped polymeric cap, does not specifically teach or suggest the claimed shaped polymer cap, or its use in the method of the George et al. patent claims. As a result, the narrower claims to the species are patentably distinct from the broader claims to the present genus. The species claims are a non-obvious over the broader genus claims, and therefore, a double-patenting rejection is not appropriate. Accordingly, it is respectfully requested that the double-patenting rejection be withdrawn.

#### **The Rejection Under 35 U.S.C. 103**

The Office Action rejects Applicants' pending claims 6-9 and 12-32 under 35 USC section 103 based on the primary reference Kinzer et al., in various combinations with secondary references Harrison et al., Smith et al., Fletcher, Schappert et al., and Kan.

Each of these rejections is based on various combinations of cited patents, all identify Kinzer et al. as the primary patent reference. The rejection is traversed because Kinzer et al. is not believed to be prior art to the pending patent application, according to paragraph 3(c) of section 103. The present application has a filing date of April 12, 1995, while Kinzer et al. has a filing date of May 22nd, 1995, a priority date of June 16, 1993, and an issue date of

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February 4, 1997. Apparently, while not expressed in the Office Action, the Kinzer et al. reference is being asserted as prior art under section 103, through section 102(e). However, section 103(c) precludes the use of this reference as prior art when the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. 35 U.S.C. section 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicants' request that the Examiner identify which portions of 35 U.S.C. sections 102 and 103 the Kinzer et al. reference is considered to fall under as a reference against Applicants' claims. Applicants believe that Kinzer et al., according to the new section 103(c) cited above, does not qualify as prior art against the pending claims because the new section 103(c) excludes 102(e) art from being used in an obviousness rejection under the stated circumstances. The outstanding rejections under 35 U.S.C. section 103 found in the Office Action, all of which use Kinzer et al. as the primary reference, should therefore be withdrawn.

The Examiner is invited to contact the undersigned, at the Examiner's convenience, should the Examiner have any questions regarding this communication or the present patent application.

Respectfully Submitted,

Respectfully submitted,

By

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### Marked-Up Copy Showing Amendments to Specification

Other materials that can be included as part of the melt-flowable sheet material are thermoplastic films. Preferably, the films are dimensionally stable at the temperatures to which they might be exposed to either in applying the melt-flowable sheet material to a substrate, e.g., when the sheet material is heated to a temperature necessary to cause flow and/or thermosetting of the sheet material, or after it has been applied, e.g., exposure to cold weather temperatures, sunlight, etc. Useful films include polyurethane films, oriented polyester films, polyimide films, polyolefin films, and the like. The films have and can be used to provide smooth surfaces for painting or as the finished surface after the melt-flowable sheet has been bonded to a surface.